

REMARKS/ARGUMENTS

Favorable reconsideration of this application in light of the following discussion is respectfully requested.

Claims 1, 3, 11, 18, 20, 22, and 40-43 are presently active. Claims 2, 4-10, 12-17, 19, 21, and 23-39 are withdrawn.

In the Office Action, Claims 1, 3 11, 40 and 41 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 7,227,097 to Kumar et al, Claims 18, 20, 22, 42 and 43 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kumar et al in view of U.S. Patent No. 5,556,500 to Hasegawa et al.

Regarding the art rejections, Claims 1 and 18 define a passive polymeric component disposed on a substrate holder and surrounding a substrate position in the semiconductor manufacturing system, as shown in Applicant's Figures 1-3 and 7. The outstanding Office Action takes the position "that the recitation that the passive polymeric component is disposed on a substrate holder and surrounding a substrate position in the semiconductor manufacturing system is considered to be a recitation of intended use of the subcombination of the claimed processing element, which the cylindrical ring-shaped processing element taught by Kumar et al would be structurally capable of performing based on the shape of a substrate holder and the placement of the processing element in a particular system."

Applicant's respectfully submit that the recitation of a passive polymeric component disposed on a substrate holder and surrounding a substrate position in the semiconductor manufacturing system is a recitation of a structural element and its recited position in the semiconductor manufacturing system. This recitation is not a recitation of an intent to use the recited passive polymeric component for a particular function. Rather, the examiner will

appreciate that this recitation defines the placement of the passive polymeric component and is not an even optional feature of the claim. This feature should be given patentable weight. Indeed, M.P.E.P. § 2143.03 requires that all words in a claim must be considered in judging the patentability of the claim against the prior art.

Accordingly, since the examiner has not found this feature to met in Kumar et al, then independent Claims 1 and 18 are not anticipated by Kumar et al. Indeed, M.P.E.P. § 2131 requires for anticipation that each and every feature of the claimed invention must be shown in as complete detail as is contained in the claim. Hence, with the above noted feature being absent from that applied references, independent Claims 1 and 18 define patentable subject matter.

Furthermore, with regard to Hasegawa et al, Hasegawa et al was previously applied in the Office Action dated December 30, 2005, and was overcome by defining that the active component was included as a part of the passive component. Hasegawa et al show in Figure 1 separated components 104 and 106, of which the Office Action has once again construed the passive component 104 to read on the claimed passive component. Yet, the Office recognized at that time element 106 to be active component.

Thus, the examiner will appreciate that the separated passive and active components in Hasegawa et al teach away from the claimed active component included as a part of the passive component. The Court in *In re Gurley*, 27 F.3d 551, 553, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994) stated that:

A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or ***would be led in a direction divergent from the path that was taken by the applicant***. The degree of teaching away will of course depend on the particular facts; in general, a reference will teach away if it suggests that the line of development flowing from the reference's disclosure is unlikely to be productive of the result sought by the applicant. [Emphasis added.]

Finally, M.P.E.P. 2141 V indicates that Office personnel should consider all rebuttal evidence that is timely presented by the applicants when reevaluating any obviousness determination. M.P.E.P. 2141 V further states that, once the applicant has presented rebuttal evidence, Office personnel should reconsider any initial obviousness determination in view of the entire record, and then should clearly communicate the Office's findings and conclusions, articulating how the conclusions are supported by the findings.

Accordingly, given the facts now brought to the examiner's attention regarding 1) the deficiencies in Kumar et al and 2) that teaching away of Hasegawa et al, it is respectfully requested that Claims 1 and 18 (and the claims dependent therefrom) be found to be non-obvious and be passed to allowance. Accordingly, it is requested that Claims 2, 4-10, 12-17, 19, 21, and 23-26 (which depend from either Claim 1 or Claim 18) be rejoined and passed to issuance.

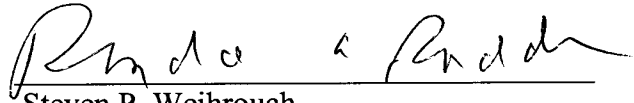
In any other case, Applicants request that the Office's findings and conclusions be clearly communicated so that Applicants can decide if further clarifications of their invention or if an appeal is in order.

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Consequently, in light of the above discussions, the outstanding grounds for rejection are believed to have been overcome. The application is believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Steven P. Weihrouch
Attorney of Record
Registration No. 32,829

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)

Ronald A. Rudder, Ph.D.
Registration No. 45,618

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